

### **REMARKS**

This responds to the Office Action mailed on December 1, 2005. Claim 10 is amended as mentioned below. Claims 1-38 remain pending in this application.

#### **Claim Objections**

Claim 10 was objected to. Pursuant to the Examiner's suggestion Applicant has amended claim 10. Reconsideration and withdrawal of the objection is respectfully requested.

#### **§102 Rejection of the Claims**

Claims 9, 37 and 38 were rejected under 35 U.S.C. § 102(b) for anticipation by Lawrence (U.S. Pat. No. 3,243,752). Applicant respectfully traverses the rejection for at least the following reasons.

The rejection regarding independent claim 9 states that Lawrence discloses attaching a trace (wire 22) of conductive material to a film of flexible insulating material. The response to Applicant's prior arguments states further that "the film of flexible insulating material in Lawrence was read as the insulating sheet of Kraft paper 24," and that the "film 24 is attached to the trace of conductive material (wire 22) because each is in direct contact with one another." The response to Applicant's prior arguments states further that "the remaining part of the film 24 is pulled with the mandrel, as the film wraps around the mandrel."

Lawrence appears to show a number of wires 22 with an insulating coating on them wrapped around a tube 20. Lawrence also appears to show a sheet 24 of Kraft paper interleaved between the winding layers. However, Applicant is unable to find in Lawrence any teaching of attaching a trace of conductive material to a substantially planar film of flexible insulating material, and attaching an end of the film to a mandrel. No conductive material is attached to the sheet 24, and the sheet 24 is not attached to the tube 20, or any other mandrel.

Applicant respectfully submits that being in "direct contact" is not analogous to "attached" as recited in claim 9. Applicant's claimed configuration has a number of advantages over a system of mere direct contact of wires and Kraft paper requiring spools of wire and hand

insertion of paper. One clear advantage includes ease of manufacturing as noted in the specification in general, and at least on page 2, lines 5-29. Further, Applicant respectfully submits that the Kraft paper 24 of Lawrence is not “attached such that when rolled the *end* (emphasis added) of the film is pulled” as recited in claim 9. If the unattached Kraft paper 24 of Lawrence can be considered pulled at all, it is clearly not pulled at an end. A number of prior windings would be required to create enough friction to hold the paper against the wire 22 that it is not attached to. Again, one advantage of attaching the film to a mandrel as claimed includes ease of manufacture.

Because the Lawrence reference does not show every element of Applicant’s independent claim 9, a 35 USC §102(b) rejection is not supported. Reconsideration and withdrawal of the rejection are respectfully requested with respect independent claim 9. Additionally, reconsideration and withdrawal of the rejection are respectfully requested with respect to the remaining claims that depend therefrom as depending on allowable base claims.

*§103 Rejection of the Claims*

Claims 10 and 34-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawrence in view of Wohlhieter (U.S. Patent No. 2,929,132). Applicant respectfully submits that the additional reference of Wohlhieter fails to cure the rejection based on Lawrence for at least the reasons outlined above.

Further, the rejection states that Wohlhieter teaches that “the solderable attaching trace 14 is electrically isolated from the trace of conductive material (winding 12) as each is isolated or separated by tape 21.” Applicant respectfully traverses the rejection, and submits that as taught in column 2, lines 44-48, “the final turn of the winding 12 is soldered to the outer terminal 14.” Applicant respectfully submits that terminal 14 (being soldered to winding 12) is not electrically isolated from winding 12. In contrast, claim 10 includes affixing a solderable attaching trace to the film, wherein the solderable attaching trace is electrically isolated from the trace of conducting material.

Because the cited references, either alone or in combination, do not show every element of Applicant’s independent claims, a 35 USC § 103(a) rejection is not supported by the

**AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE**

Serial Number: 09/736,529

Filing Date: December 13, 2000

Title: MICROCOIL CONSTRUCTION

---

Page 11

Dkt: 723.040US1

references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claims 10 and 34-36.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.


Respectfully submitted,

GERALD W. MILLS

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6944

Date 4-3-06

By   
David C. Peterson  
Reg. No. 47,857

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 30 day of March, 2006.

Name

Signature